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8/13/03**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence, including listed enclosures, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 746-3172 on August 13, 2003.

Signature: [Signature] Diane M. TsudaPATENT
Attorney Docket No. A-65353-8/RFT/RMS/RMK**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

MAYO, et al.

Serial No. 09/837,886

Filed: April 18, 2001

For: *Apparatus and Method for
Automated Protein Design*

Group No. 1637

Examiner: Kim, Young J.

CERTIFICATE OF MAILING

I hereby certify that this correspondence and enclosures are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on:

Date:

Signature: [Signature]

Diane M. Tsuda

August 13, 2003

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **California Institute of Technology**, represents that it is the assignee of the entire right, title, and interest of the instant application, USSN 09/837,886, which is a continuation of USSN 09/714,357, filed November 15, 2000, which is a continuation of 09/058,459, filed April 10, 1998, now US 6,188,965, which claims the benefit of 60/043,464, filed April 11, 1997 and 60/054,678, filed August 4, 1997.

Written assignment proof for USSN 09/058,459, is recorded in the U.S. Patent and Trademark Office at Reel/Frame 010893/0095.

California Institute of Technology hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

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In making the above disclaimer, California Institute of Technology does not disclaim the terminal part of any patent granted on the instant application, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee, California Institute of Technology.

I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

CALIFORNIA INSTITUTE OF TECHNOLOGY

Dated: August 14, 2003

By: 

Name: Adam Cochran

Title: The Intellectual Property Counsel



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AUGUST 24, 2000

PTAS

FLEHR HOHBACH TEST ALBRITTON ET AL
RICHARD F. TRECARTIN
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CALIFORNIA 94111-4187



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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 06/13/2000

REEL/FRAME: 010893/0095
NUMBER OF PAGES: 6

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

MAYO, STEPHEN L.

DOC DATE: 06/08/2000

ASSIGNOR:

DAHIYAT, BASSIL I.

DOC DATE: 06/06/2000

ASSIGNOR:

GORDON, D. BENJAMIN

DOC DATE: 06/08/2000

ASSIGNOR:

STREET, ARTHUR

DOC DATE: 06/08/2000

ASSIGNEE:

CALIFORNIA INSTITUTE OF TECHNOLOGY
1200 EAST CALIFORNIA BOULEVARD
PASADENA, CALIFORNIA 91125

SERIAL NUMBER: 09058459
PATENT NUMBER:

FILING DATE: 04/10/1998
ISSUE DATE:

COPY

FROM :XENCOR

FAX NO. :6262563562

Aug. 13 2003 12:38PM P5

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ANNE HARRELL, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

07-10-2000

FORM PTO-1595
1-01-92U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

101398932

To the Honorable Commissioner of Patents and .

documents or copy thereof.

1. Name of conveying party(ies):

STEPHEN L. MAYO
BASSIL I. DAHIYAT
D. BENJAMIN GORDON
ARTHUR STREETAdditional name(s) of conveying
party(ies) attached?☐ Yes ☒ No

3. Nature of Conveyance:

6-13-00

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other

Execution Date: JUNE 6 and 8, 2000

2. Name and address of receiving party(ies):

Name: CALIFORNIA INSTITUTE OF TECHNOLOGY

Internal Address:

Street Address: 1200 EAST CALIFORNIA BOULEVARD

City: PASADENA

State: CALIFORNIA

Zip: 91125

Additional name(s) & address(es) attached?

☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

09/058,459

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No5. Name and address of party to whom correspondence
concerning document should be mailed:

Name: RICHARD F. TRECARTIN

Internal Address: FLEHR HOHBACH TEST

ALBRITTON & HERBERT LLP

Street Address: Four Embarcadero Center

Suite 3400

City: San Francisco

State: California

Zip: 94111-4187

6. Total number of applications
and patents involved:

1

7. Total fee (37 CFR 3.41):\$ 40.00

☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit account number: 06-1300

Please debit any underpayment or credit any
overpayment to the above deposit account.

Our Order No. A-65353-3/RFT/RMS/DAV

(Attach duplicate of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a
true copy of the original document.RICHARD F. TRECARTIN
Name of Person Signing

Signature

Date

Total number of pages including cover sheet, attachments and document: [6]

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

07/07/2000 DNGUYEN 00000123 09058459

Commissioner of Patents and Trademarks

01 FC:581

40.00 OP

Box Assignments

Washington, D.C. 20231

File No. A-65353-3/RFT/RMS/DAV

1021122

ASSIGNMENT
(NOT ACCOMPANYING APPLICATION)

WHEREAS, the undersigned,

(1) STEPHEN L. MAYO, (2) BASSIL I. DAHIYAT,
(3) D. BENJAMIN GORDON, (4) ARTHUR STREET,

(hereinafter termed "Inventors"), residents of

(1) PASADENA, (2) LOS ANGELES,
(3) PASADENA, (4) LOS ANGELES,

respectively, Counties of

(1) LOS ANGELES, (2) LOS ANGELES,
(3) LOS ANGELES, (4) LOS ANGELES,

respectively, States of

(1) CALIFORNIA, (2) CALIFORNIA,
(3) CALIFORNIA, (4) CALIFORNIA,

respectively, have invented certain new and useful improvements in

APPARATUS AND METHOD FOR AUTOMATED PROTEIN DESIGN,

and have executed an application for a United States patent disclosing and identifying the invention on even date herewith; and having Serial No. 09/058,459 and filing date of April 10, 1998; and

WHEREAS, CALIFORNIA INSTITUTE OF TECHNOLOGY, a corporation of the State of CALIFORNIA, having a place of business at 1200 EAST CALIFORNIA BOULEVARD, PASADENA, State of CALIFORNIA, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee as follows:

Date: 6/8/00

(1)

STEPHEN L. MAYO

County of Los Angeles

.)

State of California

.) ss.

.)

On this 8th day of June, in the year 2000, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (1) STEPHEN L. MAYO, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person whose name is subscribed to the within instrument, and acknowledged that ~~(he)~~ she executed the same in ~~(his)~~ her authorized capacity~~(ies)~~, and that by ~~(his)~~ her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe



Date: _____

(2)

BASSIL I. DAHIYAT

County of _____

.)

.) ss.

State of _____

.)

On this _____ day of _____, in the year 2000, before me, _____, Notary Public of the State of California, personally appeared (2) BASSIL I. DAHIYAT, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature _____

(Seal)

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee as follows:

Date: _____ (1) _____
 County of _____)
) ss.
 State of _____)

On this _____ day of _____, in the year 2000, before me, _____, Notary Public of the State of California, personally appeared (1) STEPHEN L. MAYO, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature _____ (Seal)

Date: 6/6/2000 (2) _____
 County of Los Angeles)
) ss.
 State of California)

On this 6th day of June, in the year 2000, before me, Peggy E. Smith, Notary Public of the State of California, personally appeared (2) BASSIL I. DAHIYAT, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Peggy E. Smith (Seal)

Page 3a of 4

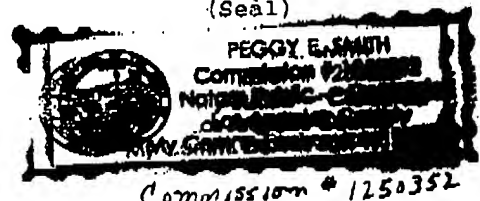
1.23 589317

5/95 (JOINT TO CORPORATE)

Page 3 of 4

Public - California

Los Angeles County
 My Comm. Expires Jan 17, 2004



Commission # 1250352

Date: 6/8/2000

(3)

D. Benjamin Gordon
D. BENJAMIN GORDONCounty of Los Angeles

.)

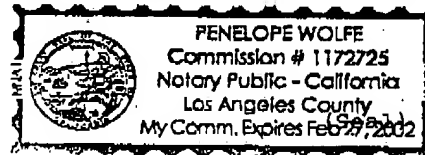
) ss.

State of California

.)

On this 8th day of June, in the year 2000, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (2) D. BENJAMIN GORDON, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity (as), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope WolfeDate: 8 June 2000

(4)

Arthur Street
ARTHUR STREETCounty of Los Angeles

.)

) ss.

State of California

.)

On this 8th day of June, in the year 2000, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (2) ARTHUR STREET, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity (as), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe

(Seal)

